

Claims 1- 47 are pending in the application, with claims 1, 39, 43 and 45 being the independent claims. Based on the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejection under the judicially created doctrine of obviousness-type double patenting

At page 3 of the Office Action, the Office provisionally rejects claims 1-47 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-67 of copending application no. 09/237,384 [hereafter, '384] and claims 1-60 of copending application 09/237,406 [hereafter, '406]. This is a provisional rejection since the claims have not yet in fact been patented. Applicant respectfully traverses the rejection.

The Office asserts that while the conflicting claims are not identical, they are not patentably distinct from each other because while the instant application claims the separation of a tocopherol from a tocopherol admixture, the tocopherol generic form of the compound, the copending applications claim the separation of a tocotrienol, or tocol from a tocol mixture, which is an isomeric/unsaturated form of the tocols. The Office further asserts that the only difference of the instant application from the copending applications is the desired product of the separation process, all being within the same class of compound, e.g., alkyl alkenyl substitute hydroxy-benzopyrans. The Office concludes that one of ordinary skill in the art would have been motivated to apply the instantly claimed invention to the other isomers of the tocols. The Office states it would have been obvious to one of ordinary skill in the art to apply the method of separation in copending applications 09/237,384 and 09/237,406 to the tocol separation by only modifying the extraction solvent selection.

In response, Applicant wishes to bring to the attention of the Office the fact that the three applications, Application Nos. 09/237,384, 09/237,406, and 09/360,947 (the instant application) are not commonly owned. The instant application, 09/360,947, is owned by Archer-Daniels-Midland Company [hereafter, ADM]. Applications 09/237,384 and 09/237,406 are currently believed to be owned by an entity other than ADM. Since the applications are not commonly owned, the provisional obviousness type double patenting rejection is improper and should be withdrawn. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

Rejections under 35 U.S.C. § 112

At page 2 of the Office Action, the Office rejects claims 2 and 12 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses the rejection.

The Office asserts that in claim 2, the recitation "does not comprise alcohol" is indefinite. The Office asserts the claiming of the extraction solvent by using negative language is extremely broad and hence indefinite. The Office further asserts that claims 22, 23 and 27 claim that the extraction solvent may be an alcohol. The Office suggests the rejection may be overcome by positively claiming the extraction solvent or by cancellation of claim 2.

Regarding claim 12, the Office asserts the recitation "an alcohol is not added to the first tocopherol mixture" is indefinite. The Office asserts that the negative claim language presumably claims the esterifying compound and as such leaves the desired compounds open

to a very broad range of possibilities. The Office suggests the rejection may be overcome by positively claiming the esterifying compound or by cancellation of claim 12.

In response to the rejection of claim 2, Applicant asserts that claim 2 is not indefinite. Determining whether a claim is definite requires an analysis of "whether one skilled in the art would understand the bounds of the claim when read in light of the specification.....If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more." *Miles Lab., Inc. v. Shandon, Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993). Negative limitations, *per se*, do not render claims indefinite. As long as the boundaries of the protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. § 112, second paragraph (MPEP, Rev. 1, February 2000, §2173.05(I), "Negative Limitations"). For example, a claim which recited the limitation "said homopolymer being free from the proteins, soaps, resins and sugars present in natural Hevea Rubber" in order to exclude the characteristics of the prior art product, was considered by the court to be definite because each recited limitation was definite. *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953). As another example, the negative limitation "incapable of forming a dye with said oxidized developing agent" was held to be definite by the court because the boundaries of the patent protection sought were clear. *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971). In particular, in *In re Bankowski* (318 F.2d 778, 783 (1963)), the court cited the then-current section of the Manual of Patent Examining Procedure (MPEP, 3rd Ed., § 706.03(d)) on negative limitations, which stated that language such as "non-poisonous" or "non-alcoholic," was not indefinite since "it leaves a single and definite alternative and may be the least cumbersome way to express the limitation."

Applicant asserts that a person skilled in the pertinent art would not be prevented from making or using Applicant's invention set forth in claim 2. Applicant further asserts that in the instant case, as in *Bankowski*, the claim language "does not comprise an alcohol" leaves a single and definite alternative, particularly since claim 2 depends from claim 1. Applicant asserts in the instant case, as in *Bankowski*, the negative claim language is the least cumbersome way to express the limitation.

Regarding the rejection of claim 12, Applicant asserts the recitation "an alcohol is not added to the first tocopherol admixture" is not indefinite. The Office argues that the language leaves the desired compounds open to a very broad range of possibilities. However, regarding the "broad range of possibilities," Applicant is not required to exemplify or to list each and every compound ("possibility") useful in the practice of the invention. Applicant asserts that the negative limitation very distinctly describes the invention because the claim clearly describes what happens prior to heating step (a): an alcohol is not added to the first tocopherol admixture. Applicant asserts that the claim limitation should be allowed because the language is definite in that any person of skill in the art can make and use the invention as claimed.

Applicant asserts that one of skill understands the bounds of the claims when read in light of the specification and that the claims, when so read, reasonably apprise those skilled in the art of the scope of the invention. Applicant respectfully submits that the rejection of claims 2 and 12 has been overcome by argument and should be withdrawn. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, is therefore respectfully requested.

Other Matters

Applicants have submitted herewith an Information Disclosure Statement and PTO-1449 form. Consideration of the documents listed thereon is respectfully requested.


Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Suzanne E. Ziska
Agent for Applicant
Registration No. 43,371

Date: October 6, 2000
1100 New York Avenue, N.W.
Suite 600
Washington, D.C. 20005-3934
(202) 371-2600